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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 12/06/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
09/452,135

Applicant(s)
Jun Fujimoto

Examiner
Andrew J. Fischer

Art Unit
2167



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 25, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) 13-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 26, and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I (claims 1-12, 26 and 27 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the search could be made without a serious burden. This is not found persuasive because of a separate status in the art and a different field of search. For example, claim 15 would require a search in article handling—class 414. See MPEP §808.02. The requirement is still deemed proper and is therefore made FINAL.
2. Claims 13-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 2 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention. See MPEP §2173.05(p) II or *Ex Parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter., 1990). Applicant is claiming a method in claim 1 and a product in claim 2.

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Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-12, 26, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow:

a. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Because the claim(s) are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention, it is unclear whether Applicant(s) are claiming a process or a machine. Again, see MPEP §2173.05(p) II.

b. In claims 3 and 5, it is not known how one of ordinary skill in the art would go about “performing . . . additional data” as recited in lines 12 and 13, and 20 and 21 respectively.

c. In claims 26 and 27, the phrase “performing data management” is indefinite since practically all data activity is data management.

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Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Claus et. al. (U.S. 5,559,313). Claus et. al. discloses the following: providing a purchaser rewritable record medium (a smart card); recording historical data representing a history of the additional data in both the data deliver's computer and the record medium (the data is stored both the smart card's tables and the merchant's computer); performing an accounting operation (adding two totals); delivering primary data (data about the purchase); reading and transmitting additional data (the identity of the user); the merchant's computer contains original data (a customer number); collating the data (in the spreadsheet); stopping delivery of the primary data (stopping the transaction) if the transmitted additional data and the retrieved corresponding data do not match (stopping the transaction if there is a problem identifying and matching the smart card user and their account(s); this is inherent in any credit, debit, or smart card transaction).

9. The Examiner interprets the "whereas if" and "only if" statements as disjunctive statements requiring only one alternative for anticipation. See *Brown v. 3M*, 265 F.3d 1349, 60 USPQ2d 1375, 1377-78 (Fed. Cir. 2001).

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10. Functional recitation(s) using the word “for” (e.g. “for storing primary data and additional data including purchaser inherent data” as recited in claim 1) have been given little patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.)

11. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant(s) to be their own lexicographer and define a claim term to have a meaning other than its ordinary and accustomed meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustomed meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 264 F.3d 1326, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (citations omitted) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”).

However, if Applicant(s) do desire any claim limitation to have a meaning other than its ordinary and accustomed meaning, the Examiner respectfully requests Applicant(s) to expressly indicate the claim limitation at issue and to show where in the specification or prosecution history the limitation is defined. Failure by Applicant(s) to address this issue in the manner set forth above or to be non-response to this issue entirely will be considered a desire by

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Applicant(s) to at least initially, give all claim limitations their ordinary and accustomed meaning. Applicant(s) are reminded that even though we start with this presumption, any interpretation disclaimed during prosecution may further limit that limitation. See *Pall Corp. v. PTI Technologies Inc.*, 259 F.3d 1383, 59 USPQ2d 1763, 1769 (Fed. Cir. 2001) (citations omitted).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Yazumi (U.S. 6,321,980 B1); Basso, Jr. et. al. (U.S. 6,131,090); Suzuki (U.S. 6,129,274); Lambert et. al. (U.S. 6,112,987); Cuervo (U.S. 6,105,009); Fleischl et. al. (U.S. 6,038,552); Kawan (U.S. 6,012,049); Kopp (U.S. 5,940,805); Bublitz et. al. (U.S. 5,869,823); Kobayashi et. al. (U.S. 5,864,825); and Mandelbaum et. al. (U.S. 5,544,246).
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.


ANDREW J. FISCHER
PATENT EXAMINER

AJF
December 2, 2001


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